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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/081,257

02/22/2002

Jeffrey W. Mankoff

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BAKER & MCKENZIE LLP  
PATENT DEPARTMENT  
2001 ROSS AVENUE  
SUITE 2300  
DALLAS, TX 75201

EXAMINER

CHAMPAGNE, DONALD

ART UNIT

PAPER NUMBER

3622

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/03/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/081,257

Applicant(s)

MANKOFF, JEFFREY W.

Examiner

Donald L. Champagne

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3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>10 sheets</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102 and 35 USC § 103*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-48, 50 and 52 are rejected under 35 U.S.C. 102(e) as being anticipated by Hassell (US 20010042010A1).

4. Hassell teaches (independent claims 1, 8, 16, 22, 30, 38 and 46) a method and database host for managing and distributing virtual document merchant coupons, and a computer program product containing said method, the method (as represented by claim 1) comprising:

a) establishing a user *database 20* on a network-connected computer (*server(s) 10*, para. [0024] and [0021]), said user database having a set of categories (in the *folio for the user*, para. [0031] and [0030]);

b) receiving at least one of said virtual document merchant coupons and its associated attribute file at said network-connected computer from an interactive television partner computer (para. [0005] and [0065]);

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c) categorizing said at least one virtual document merchant coupons according to its associated attribute file (para. [0031]); and

d) storing information from said at least one virtual document merchant coupons in one of said set of categories within said user database according to information within said attribute file (para. [0031] and [0062]).

5. For claims 30 and 38, Hassell also teaches receiving and storing the virtual document at a user computer and downloading the virtual document onto a smart card device (para. [0035] and [0066]). Hassell also teaches claim 46, where “a synchronization queue” is interpreted as the storage inherently required to properly re-assemble packets. For claims 8 and 22, the encrypted message sent to the coupon server (para. [0037]) reads on “receiving a request for a virtual document merchant coupon from an interactive television partner computer”.
6. Hassell also teaches at the citations given above claims 2-5, 9-12, 14, 15, 17-19, 23-26, 28, 29, 32, 33, 34, 36, 42, 44 and 52 (inherently), 35, 37, 40, 41, 43, 45 and 48.
7. Hassell also teaches: claims 6, 7, 20 and 21 (where the coupon *image 35*, para. [0025], para. [0026] and Fig. 2, reads on “a banner ad”); claims 13 and 27 (para. [0029] and Fig. 3 item 65); claims 31, 39 and 47 (para. 0071)); and claim 50 (para. [0034]).
8. Claims 49 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hassell. Hassell does not teach merchant contact information (claim 49) and creating an expiration reminder (claim 51). Because Hassell teaches maintaining a data warehouse accessible by merchant advertisers (para. [0062]), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add full merchant identification information to the teachings of Hassell. An expiration reminder would have been obvious as a good customer courtesy.
9. Claims 1-5, 8, 10-13, 16-19, 22, 24-26, 46 and 48-51 are rejected under 35 U.S.C. 102(b) as being anticipated by Kepecs (US006009411A).
10. Kepecs teaches (independent claims 1, 8, 16, 22, and 46) a method and database host for managing and distributing virtual document merchant coupons (col. 3 lines 18-21), and a computer program product containing said method, the method (as represented by claim 1) comprising:

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a) establishing a user database on a network-connected computer (a *Key database of the consumers' accounts* in *DAP computer 11*, col. 5 lines 54-55), said user database having a set of categories (categories of products for which coupons are available, col. 7 lines 40-52 and col. 7 line 61 to col. 8 line 11));

b) receiving at least one of said virtual document merchant coupons and its associated attribute file at said network-connected computer from an interactive television partner computer (col. 4 lines 31-40);

c) categorizing said at least one virtual document merchant coupons according to its associated attribute file (col. 7 line 61 to col. 8 line 11); and

d) storing information from said at least one virtual document merchant coupons in one of said set of categories within said user database according to information within said attribute file (col. 3 line 63 to col. 4 line 9).

8. Kepecs also teaches at the citations given above claims 2-5, 10-13, 17-19, 24-26 and 48.

9. Kepecs also teaches: claim 49 (col. 8 lines 12-14 and col. 9 lines 5-18); and claims 50 and 51 (col. 9 lines 39-44).

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.

11. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for all *formal* fax communications is 571-273-8300.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on

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access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

13. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, [www.uspto.gov](http://www.uspto.gov). At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.



DONALD L. CHAMPAGNE  
PRIMARY EXAMINER

Donald L. Champagne  
Primary Examiner  
Art Unit 3622

24 March 2007